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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,237	12/05/2001	Laurence Hubert	D/A1055	8307

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[REDACTED] EXAMINER

WOO, ISAAC M

ART UNIT	PAPER NUMBER
2172	[REDACTED]

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/683,237	HUBERT ET AL.	
	Examiner Isaac M Woo	Art Unit 2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 February 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) 18-20 is/are withdrawn from consideration. ~~canceled~~.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. Applicant elected Group I, claims 1-17, without traverse in the paper No. 5, filed on February 14, 2003.
2. Claims 18-20 are canceled and claims 1-17 are pending.

***Claim Rejections - 35 USC § 112***

3. Regarding claim 1, on line 5, the phrase "can be" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al (U.S. Patent No. 5,297,249, hereinafter, "Bernstein").

With respect to claims 1 and 8, Bernstein discloses the system for enriching (hypermedia/hypertext linking services, col. 5, lines 56-67) a document, document editor for authoring (col. 1, lines 22-29, col. 4, lines 48-50, col. 5, lines 56-67, col. 8, lines 50-59) the document, see (284, 285, FIG. 33, col. 26, lines 14-20, col. 31, lines 50-67 to col. 32, lines 1-6, col. 9, lines 51-67 to col. 10, lines 1-13); and directed search service for specifying a directed search while the document is authored with the document editor, see (col. 5, lines 56-67 to col. 6, lines 1-2); directed search service including search criteria (col. 28, 50-51, col. 29, lines 5, lines 21) and result parameters (user key is used as search parameter, col. 27, lines 1-15) that may be specified by a user, see (col. 27, lines 1-15, col. 28, 50-51, col. 29, lines 5, lines 21, col. 27, lines 1-30); result parameters including information provider parameters (col. 27, lines 27, lines 65-67 to col. 28, lines 1-18), location parameters (col. 27, lines 1-43) and form parameters; information provider parameters identifying one or more information providers to perform the directed search and provide search results, see (col. 27, lines 27, lines 65-67 to col. 28, lines 1-18); location parameters identifying where in the document the search results are to be inserted (where links go), see (FIG. 24, col. 27, lines 1-65, col. 9, lines 14-28); and form (links marker style, col. 6, lines 66-67, col. 22, lines 3-19, col. 29, lines 1-67 to col. 30, lines 1-67) parameters specifying a form in which the search results are to be

inserted into the document, see (FIG. 24, FIG. 25, col. 21, lines 55-67 to col. 22, lines 1-19, col. 28, lines 34-49). Bernstein discloses the directed search service (col. 5, lines 56-67 to col. 6, lines 1-2, col. 27, lines 1-15, col. 28, 50-51, col. 29, lines 5, lines 21, col. 27, lines 1-30). Bernstein does not explicitly disclose "inserts the directed search in the document". However, the disclosed system of Bernstein is hypermedia/hypertext linking services that provides link marker to a document (33, FIG. 3, FIG. 4A-B, FIG. 5, FIG. 22, col. 8, lines 50-67 to col. 9, lines 1-67 to col. 10, lines 1-51), which teaches that after the hypermedia/hypertext linking system searches related information (linked object), the system actually links (inserts) the linked object on the document, see (col. 9, lines 1-28). Thus, linking is the inserting the searched information on the document in the hypermedia/hypertext linking services. Therefore, it would have been obvious a person having ordinary skill in the art the time invention was made to include the inserts the directed search in the document in the system of Bernstein to provide link information for a document using the hypermedia/hypertext linking system. The hyperlink references (links) from some point in one hypertext document to (some point in) another document or another place in the same document. A browser usually displays a hyperlink in some distinguishing way, e.g. in a different color, font or style. When the user activates the link (e.g. by clicking on it with the mouse) the browser will display the target of the link. Thus, inserted hyperlink can provide detail or related reference information to a user.

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With respect to claims 2 and 9, Bernstein discloses that the form parameters are one of a link, content, and metadata, see (col.5, lines 56-67, col. 2, lines 14-62, col. 8, lines 50-67 to col. 9, lines 1-65).

With respect to claims 3 and 10, Bernstein discloses that one form parameter specifies how frequently the direct search service is to be performed, see (col. 25, lines 61-667 to col. 26, lines 1-65).

With respect to claims 4 and 12, Bernstein discloses that the information provide parameters include language, quality, quantity and cost, see (col. 28, lines 19-34).

With respect to claims 5 and 13, Bernstein discloses that the search parameters include means for specifying information provides according to a user defined criteria, see (col. 28, 50-51, col. 29, lines 5, lines 21 col. 27, lines 1-15, col. 27, lines 1-15, col. 28, 50-51, col. 29, lines 5, lines 21, col. 27, lines 1-30);

With respect to claim 6, Bernstein discloses that the meta-document server for performing the directed search and providing the search results by querying the information providers using the search criteria and inserting the search results in the document, see (col. 5, lines 56-67 to col. 6, lines 1-2, col. 27, lines 27, lines 65-67 to

col. 28, lines 1-18, 33, FIG. 3, FIG. 4A-B, FIG. 5, FIG. 22, col. 8, lines 50-67 to col. 9, lines 1-67 to col. 10, lines 1-51).

With respect to claim 7, Bernstein discloses that the search results are integrated in the document while being authored with the document editor, see (33, FIG. 3, FIG. 4A-B, FIG. 5, FIG. 22, col. 8, lines 50-67 to col. 9, lines 1-67 to col. 10, lines 1-51, col. 1, lines 22-29, col. 4, lines 48-50, col. 5, lines 56-67, col. 8, lines 50-59).

With respect to claim 11, Bernstein discloses the invoking user interface from the document editor, see (col. 26, lines 8-65).

With respect to claim 14, Bernstein discloses the exporting the document for import at other meta-document server, see (FIG. 3, FIG. 4A-B, FIG. 5, FIG. 22, col. 8, lines 50-67 to col. 9, lines 1-67 to col. 10, lines 1-51, col. 1, lines 22-29, col. 4, lines 48-50, col. 5, lines 56-67, col. 8, lines 50-59).

With respect to claim 15, Bernstein discloses, means for importing an exported meta-document, the importing means creating new meta-document with: first means for adding services in the new meta-document available at an importing meta-document server with services that map exactly to a predefined categorization; and for those services not added by the first adding means but specified in the exported meta-document, second means for adding services in the new meta-document available at

the importing meta-document server with services that map partially to a predefined categorization, and have at least one dictionary and one key in common, see (FIG. 3, FIG. 4A-B, FIG. 5, FIG. 22, col. 8, lines 50-67 to col. 9, lines 1-67 to col. 10, lines 1-51, col. 1, lines 22-29, col. 4, lines 48-50, col. 5, lines 56-67, col. 8, lines 50-59).

With respect to claim 16, Bernstein discloses, dictionaries of two services are equivalent if they map to the predefined categorization, see (FIG. 3, FIG. 4A-B, FIG. 5, FIG. 22, col. 8, lines 50-67 to col. 9, lines 1-67 to col. 10, lines 1-51).

With respect to claim 17, Bernstein discloses, two keys of a service map if they both reduce to a common generic key, see (FIG. 3, FIG. 4A-B, FIG. 5, FIG. 22, col. 8, lines 50-67 to col. 9, lines 1-67 to col. 10, lines 1-51).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jones (U.S. Patent No. 6,256,623) discloses the system for search clips that are segments of information which provide a consistent user interface and a consistent set of rules for searching varying web-based search services. Search clips are searchable (i.e. they can be accessed with a keyword search) and are displayed "in-place" on a web page. The keywords are compared to tags identifying search clips for web-based

search services. A list of hypertext links related to the keyword is displayed within a frame on the same web page. The list which is displayed in place includes hypertext links to applicable search clips, predefined topic lists, and conventional web sites where the search clips are placed at the top of the list. Information is displayed in place. Search criteria entered in a search clip are translated based on a predetermined set of search rules and any requirements of the pre-existing web-based search services that will execute the search. A template is provided which allows services to quickly define search clips such that they all have uniform characteristics.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



JEAN M. CORRIELUS  
PRIMARY EXAMINER

IMW  
April 16, 2003